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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|----------------------------------|------------------------|
| 10/562,944 | 12/29/2005 | Ian K. Engelman | 0420US-Engelman | 4404 |
| 23521 7590 11/26/2008 SALTAMAR INNOVATIONS 30 FERN LANE SOUTH PORTLAND, ME 04106 | | | EXAMINER JACKSON, BRANDON LEE | |
| | | | ART UNIT 3772 | PAPER NUMBER |
| | | | MAIL DATE 11/26/2008 | DELIVERY MODE PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|---|--|
| Office Action Summary | Application No. 10/562,944 | Applicant(s) ENGELMAN, IAN K. | |
| | Examiner BRANDON JACKSON | Art Unit 3772 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 August 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-5,7,11-18,20 and 23-26 is/are rejected.
- 7) ☒ Claim(s) 2, 6, 8-10, 19, 21-22 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 August 2008 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This office action is in response to amendments/arguments filed 8/24/2008.
Currently, claims 1-26 are pending in the instant application.

Priority

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Drawings

The drawings were received on 8/24/2008. These drawings overcome the objection from the office action, mailed 3/24/2008.

Response to Arguments

Applicant's arguments with respect to claims 1-26 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 4-5, 7, 11-14, 18, 20, and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Whiteside (US Patent 5,328,444). Whiteside discloses an articulated orthosis (11) having first and second hinged shell parts (12, 13) having inner and outer surfaces and at least one joint (14) for hinging the first and second shell parts (12, 13). The orthosis (11) comprises a tension element (23) having a first anchor point (fig. 2) coupled to the first hinged shell part (12), and a second anchor point (fig. 2) coupled to the second hinged shell parts (13). The tension element (23) has at least one generally flat outer surface (fig. 2) which is substantially coplanar to the inner surface of the orthosis (11) adjacent to the tension element (23). First and second compression surfaces (19, fig. 2) are coupled to the first and second shell parts (12, 13), respectively. A compression element (21, 31, 32) is disposed between the compression surfaces (19, fig. 2), wherein the compression surfaces (19, fig. 2) are located so as to transmit forces to the compression element (21, 31, 32) as a result of angular motion between the first and second hinged shell parts (12, 13). The forces are operable to compress the compression element (21, 31, 32). The angle between the first and second hinged shell parts (12, 13) is fully capable of being varied by the dimensions of the compression element (21, 31, 32), because the length of the compression element (21, 31, 32) will inherently vary the angle of the hinged shell parts (12, 13) relative to one another. The resistance to moment force applied to at least one of the hinged shell parts (12, 13) is varied by the modulus of elasticity of the spring (31) in the compression element (21, 31, 32). The upper hinged shell part (13) has a plurality of retaining walls forming a chamber (fig. 3) to at least partially contain the compression element (21, 31, 32),

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wherein the tension element (23) defines a boundary of the chamber (fig. 3). The compression element (21, 31, 32) is freely disposed within the chamber (fig. 3). The tension element (23) comprises an anchor points (fig. 2) transverse to the flat side. The upper compression surface (fig. 2) is integral to the to the upper hinged shell part (13). The compression element (21, 31, 32) comprises a spring (31). The tension element (23) is retained in place by forces applied by the compression element (21, 31, 32).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 3, 15-17, and 24-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Whiteside (US Patent 5,328,444). Whiteside substantially discloses

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the claimed invention; see rejections to claims 1 and 18 above. Whiteside fails to disclose the tension element has an overall bending stiffness in the between 0.2 and 0.5 Nm, and the tension element is integral to one of the hinged shell parts. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have the overall bending stiffness of the tension element be between 0.2 and 0.5 Nm, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980). This result effective variable would be optimized to the needs of each user.

Moreover, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have the tension element formed integrally with the hinged shell part, since it has been held that forming in one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art. *Howard v. Detroit Stove Works*, 150 U.S. 164 (1893).

Allowable Subject Matter

Claims 2, 6, 8-10, 19, and 21-22 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BRANDON JACKSON whose telephone number is (571)272-3414. The examiner can normally be reached on Monday - Friday 8-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patricia Bianco can be reached on (571)272-4940. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Brandon Jackson/
Examiner, Art Unit 3772

BLJ

/Patricia Bianco/

Supervisory Patent Examiner, Art Unit 3772